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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/449,707      | 11/24/1999  | PEGGY ANN CONSTANTINO | EN999104            | 6599             |

7590 05/17/2005

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EXAMINER

SHAH, SANJIV

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2176

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/449,707

Applicant(s)

CONSTANTINO

Examiner

Sanjiv D. Shah

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22-30, 33-38, 41-46, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al (herein Luchs; USPIV 4831526 -filing date 4/22/1986) in view of Hoyt et al (herein Hoyt, USPN 6067531 -filing date :7/21/1998) and in further view of Shirley et al (herein Shirley; USPN 5692206 -filing date 11/30/1994) and further in view of applicant's own admitted prior art.

Regarding claims 22, 23, 24, 34-36, 41-43, Luchs discloses an invention for creating contracts. He discloses providing for an operator to request and supplement information upon request (col 2, ln 32- 37; compare with "*an entry tool... inquiry;* "). Luchs teaches the use of common application forms (col 2, ln 26-61; compare with "*one or more model agreements;* "). Luchs teaches creating a contract document by merging stored text selected by a user upon a user's request (col 3, ln 66 - eol 4, ln 16; compare with "*a document assembler... client request;* "). Luchs also discloses storing the contract and associated data in a repository (col 4, ln 28-31; compare with "*a repository... inquiry.* ").

Luchs does not explicitly disclose processing key date reminders and approvals and storing the associated data. However, Hoyt teaches a contract negotiator/generator

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that keeps track of such information and stores that information in a repository. Hoyt's invention tracks approval modifications to a document, as well as the user that made the modifications and when they were made (col 7, ln 34-38; col 12, ln 46-49; col 22, ln 56-63; and col 32, ln 61-67). The tracking information is stored in databases (col 8, ln 33-42,). Additionally, Shirley teaches a contract generating invention that provides for tracking schedules, due dates, and other important dates (col 2, ln 15-18). Additionally, applicant's own admitted prior art as described in background of invention, page 2, lines 13-25, teaches generating SOW under a master contract.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Luchs' invention to include means for tracking the approval status and important dates associated with a contract, including storing the tracking information in a repository. Such a modification would have given an agent generating a contract more flexibility. Allowing a client to fill in clauses appropriate for the client and further allowing the agent to track the document's status and associated dates would have alleviated a communication burden if negotiating was necessary. Storing the tracking information would have allowed a user to check the contract's status with requiring the contract itself to present itself to check. Additionally generating a SOW as taught by applicant's own admitted prior art would provide for capability for handling complex execution activity.

Regarding dependent claims 25, 26, Luchs does not explicitly disclose automatically sending key date reminders to a client via e-mail. However, Hoyt discloses distributing

documents to users after the status of the document is changed (col 15, ln 30-35). The use of electronic mail to distribute documents throughout a network was known and typical at the time of the invention.

Shirley teaches incorporating an e-mail control unit for contract distribution (col 2, ln 57-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tracking tool as described in the rejection of claim 1 to send documents, including tracked information like key dates, through e-mail means. Such a modification would have improved user interface and access by delivering important documents through familiar means.

Regarding claims 27-30, 37-38, 44-46, applicant's own admitted prior art as described on page 2, lines 13-25, teaches the claimed invention of pre-approving model agreements, generating SOW, receiving inquiry to the status of SOW.

Regarding dependent claim 33, 49, Luchs does not explicitly disclose a library of supplemental provisions. However, Shirley discloses the use of additional provisions for generating contracts (col 2, ln 11-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the teaching of Shirley to the invention disclosed by Luchs. This would have given a user more opportunity for tailoring a contract to his or her needs.

3. *Claims 31, 39, 47 remain rejected under 35 U.S. C. 103(a) as being unpatentable over Luchs in view of Hoyt, Shirley, applicant's own admitted prior art and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).*

Regarding dependent claims 31, 39, 47, Luchs does not explicitly disclose model agreements in a plurality of languages. However, VAN teaches an invention for assisting users in buying and selling goods and negotiating the exchange of said goods. VAN discloses the use of the invention in multiple languages to cater to a global market (pg 1-2 and 16-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Luchs and VAN. Such a combination would have opened the use of Luchs' contract builder to a global market, instantly increasing the breadth of the invention.

4. *Claims 32, 40, 48, remain rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs in view of Hoyt, Shirley, applicant's own admitted prior art and in further view of Grubb et al (herein Grubb; USPN 5272623 -filing date 11/7/1990).*

Regarding dependent claims 32, 40, 48, Luchs does not explicitly disclose a library of alternate clauses. However, Grubb discloses maintaining a database of Government Agency Regulation clauses (GARCs) for insertion into a contract document (col 2, In 10-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two inventions to create a contract document creator with more

options for a user. A database of clauses would have given a user more opportunity for tailoring a contract to his or her needs.

Furthermore, sorting libraries was common and typical in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to organize the clause library by type. This would have presented a more logical organization for users to access and find what they needed in the library.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanjiv D. Shah  
Primary Examiner  
Art Unit 2176

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S. Shah  
May 15, 2005

A handwritten signature in black ink, appearing to read 'Sanjiv', with a stylized flourish extending from the end.

**SANJIV SHAH  
PRIMARY EXAMINER**